

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner:

rejected claims 1-4 and 6-8 under 35 U.S.C. § 101;

rejected claims 9-12 and 14-16 under 35 U.S.C. § 112, second paragraph;

rejected claims 1, 4, 9, 12, and 17 under 35 U.S.C. § 103(a) as being unpatentable over a translation of JP 2000-187631 to Sakamaki ("Sakamaki") in view of U.S. Patent Application Publication No. 2002/0059244 to Bunney et al. ("*Bunney*");

rejected claims 2, 3, 10, 11, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Sakamaki in view of U.S. Patent No. 6,519,571 to Guheen et al. ("*Guheen*");

rejected claims 6, 8, 14, 16, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Sakamaki in view of U.S. Patent No. 6,493,673 to Smith et al. ("*Smith*") and Bunney; and

rejected claims 7, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Sakamaki in view of U.S. Patent No. 6,571,234 to Knight et al. ("*Knight*") and Bunney.

Applicants have amended claims 1, 2, 6, 8-10, 14, and 16-19, canceled claims 7, 15, and 20, and added new dependent claims 21-26. Claims 1-4, 6, 8, 9-12, 14, 16-19, and 21-26 are pending.

In light of the following remarks, Applicants respectfully request the Examiner's timely reconsideration and allowance of the currently pending claims.

**I. The Rejection of Claims 1-4 and 6-8 under 35 U.S.C. § 101**

The Office Action states that claims 1-4 and 6-8 are susceptible to interpretation as non-statutory software (Office Action at p. 3). Amended independent claims 1, 2,

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<sup>1</sup> The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the final Office Action.

and 6 recite a "processor," and therefore each recites a statutory machine. Claims 3 and 4 depend from claim 2, claim 8 depends from claim 6, and were apparently rejected solely due to their dependence. Claim 7 has been canceled. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of remaining claims 1-4 and 6-8 under 35 U.S.C. § 101.

**II. The Rejection of Claims 9-12 and 14-16 under 35 U.S.C. § 112, second paragraph**

The Office Action states that claims 9, 10, 14, and 15 recite "wherein" clauses that do not recite positive steps (Office Action at p. 4). Although Applicants respectfully disagree, claims 9 and 14 have been amended to delete the "wherein" clauses in order to expedite prosecution. Claim 15 has been canceled, and claim 10, either as previously presented or as amended herein, does not contain a wherein clause.

Claim 12 depends from claim 9, claim 11 depends from claim 10, and claim 16 depends from claim 14, and were apparently rejected solely due to their dependence. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of remaining claims 9-12, 14, and 16 under 35 U.S.C. § 112, second paragraph.

**III. The Rejection of Claims 1, 4, 9, 12, and 17 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1, 4, 9, 12, and 17 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A

conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145.

Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made.

M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) . . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the

prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, for example, recites a community-based collaborative knowledge system, comprising a "message subscription type setting means for setting a second subscription type for the second virtual community ... the second subscription type comprising using an email client for the second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying, using the email client, to a delivered email message containing a new posting" (emphasis added).

*Sakamaki* discloses an "information releasing system" including terminals 1a-1n, a server 2, and a network 3 (*Sakamaki*, ¶¶ 18-19). *Sakamaki*'s system allows posting various comments to an online bulletin board (*Sakamaki*, ¶ 81 and FIG. 22(a).

*Sakamaki* discloses two "releasing formats" for users of the forum to read newly posted comments (*Sakamaki*, ¶¶ 84-85). *Sakamaki*'s releasing formats include a "Web format" where a user receives emails embedded with a link to the bulletin board, thus allowing the user to read the newly posted comment by navigating to the bulletin board using a web browser (*Sakamaki*, ¶ 85).

*Sakamaki* also discloses a "mail" releasing format (*Sakamaki*, ¶ 85). As the Office Action correctly states, the mail releasing format allows "registering to receive email message containing a new posting and delivering email message containing a new posting to a user" (Office Action at p. 2, citing *Sakamaki*, ¶ 75). The Office Action

further states that “a user may post a new posting to a forum ...the new posting by the user is a reply to the delivered email message” (Office Action at p. 3).

However, even assuming the Examiner is correct in interpreting a new forum posting as a “reply” to an email (a position Applicants do not concede), amended claim 1 recites “allowing a user to post a reply to the second virtual community by replying, using the email client, to a delivered email message containing a new posting” (emphasis added). *Sakamaki*’s users are limited to posting replies using the bulletin board interface to select a “post” icon (*Sakamaki*, ¶ 81), and do not have the option of posting replies to the bulletin board using an email client. Therefore, *Sakamaki* does not teach or suggest a “second subscription type allowing a user to post a reply to the second virtual community by replying, using the email client, to a delivered email message containing a new posting” (emphasis added) as recited by independent claim 1.

*Bunney* fails to cure these deficiencies of *Sakamaki*. *Bunney* discloses a server computer adapted to transmit a document to a client computer (*Bunney*, abstract). *Bunney* also discloses selecting an icon 43 to add links to a user’s personal menu (*Bunney*, ¶ 61), and allowing a user to edit the menu (*Bunney*, ¶ 63). However, *Bunney*’s personal menu does not allow a user to set a subscription type so that the user can respond to forums or virtual communities by replying to an email. Therefore, *Bunney* also does not teach or suggest a “second subscription type allowing a user to post a reply to the second virtual community by replying, using the email client, to a

delivered email message containing a new posting" (emphasis added) as recited by independent claim 1.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why independent claim 1 would have been obvious to one of ordinary skill in view of the art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a).

Independent claims 9 and 17, although of different scope from claim 1 and from each other, recite elements similar to those discussed above with respect to claim 1. Accordingly, for at least the reasons discussed above with respect to claim 1, no *prima facie* case of obviousness has been established for claims 9 and 17. Therefore, the Examiner should withdraw the rejection of claims 9 and 17 under 35 U.S.C. § 103(a).

Claim 4 depends from claim 1 and claim 12 depends from claim 9, and therefore the dependent claims include all the elements recited in the independent claims. Accordingly, no *prima facie* case has been established with respect to claims 4 and 9 at least due to their dependence. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 4 and 12 under 35 U.S.C. § 103(a).

**IV. The Rejection of Claims 2, 3, 10, 11, and 18 under 35 U.S.C. § 103(a)**

Independent claims 2, 10, and 18, although of different scope from claim 1 and from each other, recite elements similar to those discussed above with respect to claim

1. As discussed, *Sakamaki* does not teach or suggest a "second subscription type allowing a user to post a reply to the second virtual community by replying, using the email client, to a delivered email message containing a new posting" (emphasis added) as recited by independent claim 1.

*Guheen* fails to cure the deficiencies of *Sakamaki*. *Guheen* discloses utilizing various types of user indicia to customize a user interface (*Guheen*, abstract). *Guheen* also discloses allowing "participation" in discussions such as newsgroups or forums "via email" (*Guheen*, col. 207, lines 40-49). However, *Guheen* does not teach or suggest that participating is done, for example, by replying to a delivered email message that contains a new posting to the newsgroup or forum. Therefore, *Guheen* also does not teach or suggest the features of these independent claims.

In view of the above, the final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the final Office Action has failed to clearly articulate a reason why independent claims 2, 10, and 18 would have been obvious to one of ordinary skill in view of the art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of independent claims 2, 10, and 18 under 35 U.S.C. § 103(a).

Claim 3 depends from claim 2, and claim 11 depends from claim 10, and therefore the dependent claims include all the elements recited in the independent claims. Accordingly, no *prima facie* case has been established with respect to claims 3

and 11 at least due to their dependence. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 3 and 11 under 35 U.S.C. § 103(a).

**V. The Rejection of Claims 6, 8, 14, 16, and 19 under 35 U.S.C. § 103(a)**

Independent claim 6, for example, recites a community-based collaborative knowledge system, comprising a “reply message processing means for, when a reply email message used to post a reply message is sent back from the client terminal in response to an email message comprising a header, subject, and a message text, delivering the categorized and accumulated message to a subscriber, determining whether or not the header of the reply email message includes an ID, and categorizing and accumulating the reply message based on whether the header of the reply email message includes the ID” (emphasis added).

As discussed, *Sakamaki* discloses an “information releasing system” comprising terminals 1a-1n, a server 2, and a network 3 (*Sakamaki*, ¶¶ 18-19), and *Sakamaki*’s system allows posting various comments to an online bulletin board (*Sakamaki*, ¶ 81 and FIG. 22(a)). *Sakamaki* discloses two “releasing formats” for users of the forum to read newly posted comments (*Sakamaki*, ¶¶ 84-85). But, *Sakamaki* does not disclose determining whether the header of an email contains an ID, or categorizing reply messages by an ID. Therefore, *Sakamaki* does not teach or suggest a “reply message processing means for, when a reply email message used to post a reply message is sent back from the client terminal in response to an email message comprising a header, subject, and a message text, delivering the categorized and accumulated message to a subscriber, determining whether or not the header of the reply email



message includes an ID, and categorizing and accumulating the reply message based on whether the header of the reply email message includes the ID" (emphasis added) as recited by independent claim 6.

*Bunney* fails to cure the deficiencies of *Sakamaki*. As discussed, *Bunney* discloses a server computer adapted to transmit a document to a client computer (*Bunney*, abstract). However, *Bunney*'s personal menu does not allow a user to set a subscription type so that the user can respond to forums or virtual communities by replying to an email. Further, *Bunney*'s server computer does not determine whether the header of an email contains an ID, or categorize reply messages by an ID. Therefore, *Bunney* does not teach or suggest a "reply message processing means for, when a reply email message used to post a reply message is sent back from the client terminal in response to an email message comprising a header, subject, and a message text, delivering the categorized and accumulated message to a subscriber, determining whether or not the header of the reply email message includes an ID, and categorizing and accumulating the reply message based on whether the header of the reply email message includes the ID" (emphasis added) as recited by independent claim 6.

*Smith* fails to cure the deficiencies of *Sakamaki* and *Bunney*. *Smith* discloses a visualization system that provides improved visualizations of relationships and connections in collaborative information such as email, chats, and bulletin boards (*Smith*, abstract). *Smith* also discloses newsgroup postings or messages include a header and body, and that the header includes routings, categorization, and authorship information regarding the post (*Smith*, col. 7, lines 34-46). However, *Smith*'s system

does not determine whether the header of an email contains an ID, or categorize reply messages by an ID. Therefore, *Smith* does not teach or suggest “a displayed window indicating ... a second subscription type is using an email client for [a] second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting” (emphasis added) as recited by independent claim 6.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why independent claim 6 would have been obvious to one of ordinary skill in view of the art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of independent claim 6 under 35 U.S.C. § 103(a).

Independent claims 14 and 19, although of different scope from claim 6 and from each other, recite elements similar to those discussed above with respect to claim 6. Accordingly, for at least the reasons discussed above with respect to claim 6, no *prima facie* case of obviousness has been established for claims 14 and 19. Therefore, the Examiner should withdraw the rejection of claims 14 and 19 under 35 U.S.C. § 103(a).

Claim 8 depends from claim 6, and claim 16 depends from claim 14, and therefore the dependent claims include all the elements recited in the independent claims. Accordingly, no *prima facie* case has been established with respect to claims 8

and 16 at least due to their dependence. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 8 and 16 under 35 U.S.C. § 103(a).

**VI. The Rejection of Claims 7, 15, and 20 under 35 U.S.C. § 103(a)**

Claims 7, 15, and 20 have been canceled, rendering the rejection moot.

**VII. New Dependent Claims 21-26**

New dependent claims 21-23 is allowable over the cited art at least due to their dependence from allowable claim 6, and new dependent claims 24-26 are allowable at least due to their dependence from allowable claim 14. Accordingly, Applicants respectfully request that the Examiner allow new dependent claims 21-26.

**VIII. Conclusion**

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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